

REMARKS

After entry of the foregoing amendment, claims 1-2, 4-6, 8 and 10-22 remain pending in the application.

The specification has been amended to update a reference to a previously-pending, now issued, patent.

Claim 1 is rejected under § 103 over Price (4,765,519) in view of Rhoads (6,311,214). Claims 2, 7-9 and 20 stand rejected under § 103 over Rhoads alone. Claim 3 stands rejected under § 103 over Rhoads in view of Lemelson (5,945,656). Claims 4-6 stand rejected under § 103 over Rhoads and Lemelson, and further in view of Linebarger. Claim 10 stands rejected under § 103 over Rhoads in view of Marggraff (6,750,978). Claims 11-15 stand rejected under § 103 over Rhoads and Lemelson, and further in view of LaTour (5,888,070) and Linebarger. Claims 21-22 stand rejected over Lo (6,089,943) in view of Lemelson and Rhoads.

Thus, Rhoads '214 is an element of each of the rejections.

Rhoads '214 is owned by Digimarc Corporation, the assignee of the present application. Because of such common ownership, Rhoads '214 is not believed to be available as prior art.

Rhoads '214 was filed before the present application was filed, but issued after. (Rhoads '214 was filed June 29, 1999, and issued October 30, 2001. The earliest priority date for the present application is August 30, 1999.) Accordingly, the Rhoads '214 patent is nominally § 102(e) art. However, § 103(c)(1) provides that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The undersigned, as attorney of record, hereby states that the present application and Rhoads '214 were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Digimarc Corporation. (MPEP § 706.02(I)(3).)

Accordingly, pursuant to § 103(c)(1), Rhoads '214 is not believed to be available as prior art.

That said, the present assignee foreshadowed commercial release of certain embodiments detailed in Rhoads '214 by the below-quoted, and similar, statements included in a stock prospectus (Form S-1) filed with the US Securities and Exchange Commission, on September 21, 1999:

We are also using our technologies to develop products we call Paper-as-Portal applications, the first of which, named b'doop, is planned for release in the second half of 2000. This application is intended to enable imperceptible digital code to be embedded within print media, such as magazine advertisements or articles, direct mail coupons or catalogs and bank cards or business cards. When recognized by PC cameras enabled by our patented reader technology, the code will automatically launch the user to the specific Internet destination chosen by the producer of the printed content. In this way, we believe that b'doop will deliver more efficient Internet navigation and access to consumers and more effective means for print advertisers to link readers directly to a targeted e-commerce point-of-sale.¹

Applicants make no admission that this particular prospectus is § 102(a) prior art (e.g., due to questions about its practical accessibility to artisans). However, other descriptions of this b'doop technology (later termed Digimarc MediaBridge) were published prior to the filing of this application. (Copies of such art are enclosed with the IDS accompanying this amendment.) Accordingly, these other documents might be cited as § 102(a) art against portions of the present disclosure that were newly introduced at the time of its November, 2000, filing date.

Turning to claim 1, the claim has been amended to better track the disclosure of the August, 1999, priority application. Rhoads '214 is not available as prior art for reasons given above. The cited press releases and other materials identified in the accompanying IDS post-date this priority disclosure. Accordingly, claim 1 is believed to be patentable over the art.

¹ This excerpt is found on page labeled '1' at the bottom (actually, the 5th page of the document submitted with the accompanying IDS).

Likewise, each limitation found in claim 2 – after amendment – is believed to be supported by the August, 1999, priority application, and is thus believed to be patentable over the art.

Claims 4-6 include subject matter not literally disclosed in the August, 1999, priority application. However, applicants respectfully submit that such combinations are not unpatentable over Rhoads (Digimarc MediaBridge) in view of Lemelson (5,945,656²) and further in view of Linebarger (6,068,485).

One reason is that none of the art teaches certain of the claims' limitations. For example, claim 5 requires that the stored phonemes "correspond to a child or a child's family member." Similarly, claim 6 requires that the phonemes "correspond to a celebrity voice."

The Action dismisses these choices as obvious design choices. However, they are choices not presented by the prior art, which do not teach such arrangements.

The Action faults applicants for not disclosing advantages associated with such features. However, it will be recognized that applicants are not required to do so.

That said, it will be recognized that there are clear advantages to arrangements incorporating such limitations. A child's attention is more likely to be engaged if the sound coming from the system is their own – or that of a parent, instead of the voice of a stranger. Similarly, the voice of a celebrity such as Sesame Street's Cookie Monster is also more likely to capture the child's attention.

Since the art cannot be combined to yield the arrangements of claims 5 and 6, these claims are properly patentable.

Moreover, each of claims 4-6 is patentable because the Action failed to present a compelling rationale explaining why an artisan would have found it obvious to combine the three cited references in the manners asserted. The Action asserts that the combination would be obvious because – once combined – the system "is easy and simple to use." It will be recognized, however, that this is a hindsight rationale. And an overbroad one as well – not guiding the artisan with the specificity needed to enable such

² The Action refers to 5,545,656, which is believed to be a typo.

a person to decide what features of each of the three references to adopt, which to change (and why), and which to disregard as undesirable.

Accordingly, claims 4-6 are each believed properly patentable over the art.

Claim 8 is rejected on Rhoads '214 alone. As noted, Rhoads is not prior art.

(Additionally, applicants respectfully traverse the Action's leap from the greeting card disclosure in Rhoads '214 to the "printing artwork for coloring by a child" of claim 8.)

Claim 8, as well as claims 10 and 11, have been rewritten in independent form. In so doing, applicants have omitted certain limitations originally found in claim 2 and otherwise broadened the claims.

Claim 10 stands rejected over Rhoads in view of Marggraff. As noted above, Rhoads is not available as prior art. Accordingly, the rejection is not further addressed.

Claim 11-15 stand rejected over a combination of four references, including Rhoads. Likewise, claims 21-22 stand rejected over a combination of art including Rhoads. Again, Rhoads is not available as prior art. Accordingly, these rejections are not further addressed.

The indication of allowable subject matter in claims 15-19 is noted with appreciation.

In view of the foregoing amendments and remarks, applicants solicit a notice indicating the allowance of claims 1-2, 4-6, 8 and 10-22.

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Respectfully submitted,

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